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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

COWGILL et al.

Serial No.: 08/477,984

Group Art Unit: 1654

Filing Date: June 7, 1995

Examiner: A. Gupta

Title: METHODS FOR PURIFYING AUTHENTIC IGF FROM YEAST HOSTS

PETITION TO RE-OPEN PROSECUTION

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Commissioner for Patents
Washington, D.C. 20231

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**SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS**

Sir:

Pursuant to 37 CFR 1.181(a), Applicants petition the Commissioner to re-open prosecution in the above-referenced case.

The status of the case is as follows. A final rejection was mailed December 4, 1998 (Paper No. 24) in the above-referenced application. In that Action, Examiner A. Gupta finally rejected claims 1, 3-5, 7-12, 17, 18, 47, 49-51, 53-58, 63 and 64 under 35 U.S.C. §103. A response to the final rejection which included a Declaration Pursuant to 37 C.F.R. §1.131, signed by each of the inventors and believed to overcome the only outstanding issue, and a Notice of Appeal were filed **June 4, 1999**. The return receipt postcard of Applicants' response and accompanying documents is attached hereto.

Despite repeated conversations with representatives of the Patent Office prior to the deadline for filing a brief on appeal (including conversations with Examiner

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Gupta, Examiner Tsang and Examiner Low), Applicants were unable to obtain the status of the application. In spite of these repeated efforts to determine the status of the case, neither a Notice of Allowance nor an Advisory Action were forthcoming prior the **January 4, 2000** deadline, six months after the response was filed.

In the absence of input from the Patent Office, Applicants filed an Appeal Brief on the January 4, 2000 deadline. The return receipt postcard of Applicants' appeal brief is attached hereto. In that brief, Applicants addressed all of the outstanding issues of which they were aware, but, because of the lack of input from the Office, could only guess at the status of the application following the response and Rule 131 Declaration filed June 4, 1999.

After the January 4th deadline for submitting an Appeal Brief, Applicants received an Advisory Action, dated **January 13, 2000**. In the Advisory Action, Examiner A. Gupta asserts that the Declaration under 37 C.F.R. 1.131 is not effective and maintains the rejections. With regard to the Declaration, the Examiner alleges it is insufficient because "no factual evidence [was] submitted that the contemplation [of the method] was actually reduced to practice." (Advisory Action, page 2). This is clear error on the part of the Examiner. It is axiomatic that "averments made in a 37 CFR 1.131 affidavit or declaration, do not require corroboration." (See, MPEP § 715.07, citing *Ex parte Hook*, 102 UPSQ 130 (BPAI 1953)). Applicants Rule 131 Declaration (and attached exhibit) details conception of a specific procedure prior to the effective date of the reference. Furthermore, Applicants aver in the Declaration that they worked diligently to develop and optimize the claimed purification process. Thus, because no corroboration of diligence is required in the Rule 131 context, the Declaration is sufficient to antedate the reference at issue.

In view of the clear error in the Advisory Action and the fact that Applicants had no possible opportunity to address this error in their Appeal Brief, Applicants request that this case be re-opened for prosecution so that may have the opportunity to fully and fairly address this issue with the Examiner. Applicants note that they have not yet received an Examiner's Answer, due March 4, 2000. If prosecution is not re-opened, Applicants will either file a Supplemental Brief or, if an Examiner's answer is

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forthcoming, a Reply Brief, addressing this error so that this issue can be resolved on appeal.

Based on the foregoing, Applicants respectfully request that prosecution be re-opened.

The Commissioner is authorized to charge any required fees required by this Paper to deposit account number 18-1648.

Respectfully submitted,

Date: 2/29/2000

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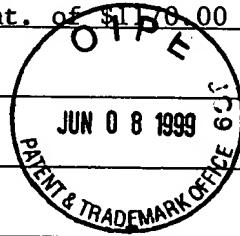
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ATTORNEY DOCKET 1087.001 DATE June 4, 1999
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1) Amendment Transmittal Letter (2 pages); 2) Response Under 37 CFR 1.116 (4 pages); 3) Declaration Pursuant to 37 CFR 1.131 signed by Luis Juarbe-Osorio with attachments (6 pages);
4) Declaration Pursuant to 37 CFR 1.131 signed by Cynthia Cowgill, Patricio Riquelme, Glenn Dorin, Christopher M. Bussineau and Robert D. Kudrna with attachments (6 pages);
5) Petition for Extension of Time (2 pages); 6) Notice of PAPER: Appeal (2 pages); 7) Check in the amt. of \$110.00 and
8) Return receipt postcard
INVENTOR: COWGILL et al.

SERIAL NO.: 08/477,984

FILING DATE: June 7, 1995



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✓ ATTORNEY DOCKET 2300-1087 DATE Jan. 4, 2000
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- IN TRIPPLICATE:
Appeal Brief Transmittal; Petition for Extension of
Time; Appeal Brief; Appendix A (claims); Appendix B
(copy of Rule 131 Declaration); \$2150

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